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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,630	04/06/2001	Eric J. Sprunk	18926003160	9042

7590 04/19/2006

GENERAL INSTRUMENT CORPORATION  
101 Tournament Drive  
Horsham, PA 19044

EXAMINER

PICH, PONNOREAY

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/827,630	SPRUNK, ERIC J.	
Examiner	Art Unit	
Ponnoreay Pich	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 27 January 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-7 and 11-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-7 and 11-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_\_  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5) Notice of Informal Patent Application (PTO-152)  
Paper No(s)/Mail Date. \_\_\_\_\_ 6) Other: \_\_\_\_\_

## DETAILED ACTION

Claims 1-7 and 11-14 are pending. Applicant's amendments and arguments have been considered. Applicant's declaration and evidence submitted were also considered. Any objections or rejections not repeated below for record are withdrawn due to applicant's amendments and/or arguments. Any well known art statements not specifically traversed by applicant are taken as admittance of prior art as per MPEP 2144.03.

### ***Response to Arguments***

The examiner had objected to the oath in the previous office action because applicant had failed to properly claim priority to earlier filed applications. Applicant has yet to fix the defect in the oath, thus the effective filing date of the current application is still considered the actual filing date, i.e. 4/6/2001.

The declaration filed on 1/27/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Epstein reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Epstein reference to either a constructive reduction to practice or an actual reduction to practice. The effective date of the Epstein reference is 7/14/1998. Applicant's declaration and evidence submitted does not show any diligence from 7/14/1998 to either the date of actual reduction to practice or the effective filing date of the current application, i.e. the date of constructive reduction to practice. The earliest date the examiner can find which appears to indicate that an actual reduction to practice might have occurred appears to be around September 1999

as evidenced by item 8 in section II of the Invention Record Form. However, the examiner notes that applicant did not provide any evidence of facts that actual reduction to practice actually occurred on that date. Applicant also failed to provide any explanation or evidence for the lack diligence. The examiner notes that item 4 of the declaration states that the inventor constructively reduced the invention to practice prior to June 2, 1998. However, this statement is incorrect since date of constructive reduction to practice of an invention is the effective filing date of the application. In this case, it is 4/6/2001. At most the "Application Security for TCI" memorandum referenced in item 4 of the declaration shows conception of the invention prior to June 2, 1998. There does not appear to be anything in the memorandum which indicates an actual reduction to practice and applicant has not pointed out anything specific in the memorandum which shows an actual reduction to practice.

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country prior to or after the effective date of the Epstein reference. Though the Invention Record Form indicates that the invention was built and tested by at least September 1999, the declaration and evidence failed to establish that the actual reduction to practice occurred in this country or a NAFTA or WTO member country. In fact, there is not any mention of the country in which the actual reduction to practice occurred. There also does not appear to be any evidence submitted by applicant showing that actual reduction to practice occurred for the claimed invention. The

Invention Record Form indicates that a working model of the invention was built and tested on 1999, but no evidence of fact has been presented by applicant.

The June 2, 1998 memorandum also does not indicate whether the memorandum was a confidential internal memo or whether the public had access to the memorandum. Since the memorandum discloses the invention and was written more than one year to the filing date of the current application, such information is pertinent to the patentability of the current application. The examiner respectfully requests under 37 CFR 1.105 that applicant indicate on record whether or not the memorandum was a confidential internal memo and whether at any point before the filing of the current application the public had access to the memo. If the public had access to the memo, applicant also needs to indicate the date that the public had access to the memo if it was more than a year from the effective filing date of the current application. If the memo was confidential and the public never had access to it, applicant can just state that it was confidential and was never accessible by the public.

The declaration is also insufficient to overcome the Epstein reference because applicant failed to clearly explain which facts or data applicant is relying on to show completion of his invention prior to the date of the Epstein reference (see MPEP 715.07). Applicant states in item 2 of the declaration that claims 1-7 and 11-14 were described in an "Invention Record Form" on 10/5/1999. Item 3 states that claims 1-7 and 11-14 were conceived prior to the date of the Epstein reference as evidenced by the "Application Security for TCI" document. However, applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on

by applicant. Especially with the "Invention Record Form", the examiner has a difficult time understanding what the inventor has written due to the inventor's handwriting, so applicant should clearly explain the evidence presented and map how the evidence presented shows that applicant had priority over the limitations claimed (see MPEP 715.07).

***Oath/Declaration***

The oath makes no mention of priority claim to applications 09/580303, 60/0158491, 60/165094, and 60/174037. If applicant wants to be granted the rights to an earlier effective filing date, applicant must fix this defect in the oath. Until such time, the actual filing date of the current application will be considered the effective filing date.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Epstein (US 6,865,675).

**Claim 1:**

Epstein discloses:

1. Receiving a secure portion of a secure object (Fig 4 and col 6, lines 47-58).
2. Receiving a plaintext remainder of the secure object (Fig 4 and col 6, lines 47-58).
3. Determining which portion of the secure object is the secure portion (Fig 4 and col 6, lines 58-61).
4. Decrypting the secure portion to provide a plaintext portion (Fig 4 and col 6, lines 58-61).

Epstein further inherently discloses forming the plaintext object that comprises the plaintext portion and the plaintext remainder and storing the plaintext object (Fig 4). Note that on page 6 of applicant's specification, an object is defied as "any collection of digital information." The examiner submits that the decrypted ticket along with the content data disclosed by Epstein comprises the plaintext object, as together they are a collection of digital information and they are both in non-encrypted format. Further, a valid ticket is needed to enable access to the content data, so the ticket must always be located with the digital content (Fig 4). The examiner further submits that to display the content using the display device, the plaintext content must also be stored by the display device to some degree.

**Claim 2:**

Epstein further discloses:

1. Selecting a secure portion of the plaintext object to encrypt (Fig 4 and col 12, lines 21-26).

2. Encrypting the secure portion (Fig 4 and col 12, lines 21-26).
3. Sending the secure portion and the plaintext remainder to a set to box (Fig 4 and lines 24-26).
4. Providing a key that is used in decryption of the secure portion (Fig 4 and col 12, lines 4-7 and 26-30).

**Claim 3:**

Epstein inherently discloses reporting purchase of the plaintext object a point away from the set top box (col 9, lines 16-21). Epstein discloses that the sink device makes a request to the source device to begin transmission of the protected content to the sink device (col 9, lines 16-21). The examiner submits that this reads on the limitation recited in claim 3 as the source device is a point away from the set top box and the set top box must provide proof of purchase or make a purchase at the source device before the source device would transmit the plaintext object. One of ordinary skill should appreciate that if the source device transmits the plaintext object (which includes a valid ticket) without first receiving proof of purchase, then there would be no point to the conditional access system disclosed by Epstein for controlling access to protected content.

**Claim 5:**

Epstein inherently discloses wherein the decrypting step comprises a step of decrypting the secure portion with an access control processor (col 9, lines 55-65).

**Claim 7:**

Claim 7 is substantially similar to claim 2 and is rejected for the same reasons. The difference between the two claims lies in the preamble. Claim 2 recites a set top box, while claim 7 recites a conditional access system. However, the examiner submits that a set top box is inherently part of a conditional access system.

**Claim 11:**

Epstein inherently discloses wherein removal of the secure portion from the plaintext object renders the plaintext object inoperable (Fig 4). The secure portion, i.e. encrypted ticket, is needed to enable access to the digital content (Fig 4). It is inherent that if the ticket was removed from the plaintext object that the plaintext object would be rendered inoperable.

**Claim 12:**

Epstein further discloses a step of changing authorization of the set top box from a point remote to the content receiver (Fig 4). Note the conditional access device sends the ticket which authorizes the set top box to access the content. The conditional access device is at a point remote from the receiver.

**Claim 13:**

The limitation recited in claim 13 is substantially similar to the one rejected in claim 3 and is rejected for the same reasons. The difference is that claim 3 recites reporting the purchase while claim 13 recites receiving the purchase information. Both language essentially amounts to the same thing, however, as the purchase information cannot be received unless it was reported.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein (US 6,865,675).

**Claim 6:**

Epstein does not explicitly disclose the secure portion is less than one-half the size of the secure object. However, the secure portion is the encrypted ticket, which once decrypted is hashed to determine if it matches the watermark of the digital content (Fig 4). The ticket itself was originally derived from the watermark via a hash function (col 3, lines 26-27). The digital content can comprise any type of digital content including MPEG data (col 8, lines 29-44). One of ordinary skill should appreciate that traditionally a watermark is substantially smaller than the content it is encoded in, so this means that the watermark is less than one-half the size of the digital content. As the ticket is derived from the watermark, it should be obvious to one of ordinary skill that the secure portion (i.e. encrypt ticket) is less than one-half the size of the secure object, which comprises the encrypted ticket and the watermarked digital content.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein (US 6,865,675) in view of Wasilewski et al (US 6,157,719).

**Claim 4:**

Epstein does not explicitly disclose wherein the second listed receiving step is performed before the reporting step. However, Wasilewski discloses that at the time the applicant's invention was made, it was common to permit access to broadcast information only to those who paid for it, which was usually done via scrambling the content (col 1, line 65-col 2, line 5).

It is obvious from Wasilewski's teachings that it is common practice for the content to be continuously transmitted to the set top box, but only once the content is purchased and the purchase was reported would the set top box be allowed access to the content. In the case of Epstein's invention, one of ordinary skill should appreciate that enablement of the content data would be through the receipt of a valid ticket at the set top box. Thus, the second listed receiving step would have commonly been performed before the reporting step. One of ordinary skill would have been motivated to incorporate Wasilewski's teachings because he teaches that what he disclosed was one of the common alternatives to making money by distributing information on a broadcast medium (col 1, lines 61-63).

Note that it would have been just as obvious to send the plaintext remainder before after the purchase was reported. The choice of when to do the sending is arbitrary as the receiver cannot use the content until a valid ticket is sent and a valid ticket would not be sent until a purchase is reported. Either choice would not differentiate from the spirit of Epstein's invention.

**Claim 14:**

Epstein does not disclose the key is a symmetric key. However, Wasilewski discloses a key being a symmetric key (col 6, lines 18-23). It would have been obvious to one of ordinary skill in the art at the time the application's invention was made to have incorporated Wasilewski's teachings with Epstein so that the key is a symmetric key. One of ordinary skill would have been motivated to incorporate Wasilewski's teachings as he discloses that his teachings would permit an easy way of permitting a customer to change entitlement agents as he or she sees fit (col 10, lines 50-51).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Examiner  
Art Unit 2135

  
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PRIMARY EXAMINER

PP

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